APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,368	10/16/2000	Tracey L. Jones	28150.11	3107

27683   7590   07/26/2005

HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

EXAMINER
LUDWIG, MATTHEW J

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 July 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed 7/5/05.

2.   Claims 1-24 are pending in the case. Claims 1, 9, and 17, are independent claims.

3.   Claims 1-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5.   **Claims 1, 9, and 17, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to independent claims 1, 9, and 17, the examiner believes the vexatious nature of the claim language found within the independent claims include vague and indefinite language. The language fails to provide one of ordinary skill in the art the necessary steps to successfully carry out the invention. More specifically, the phrase, '*storing a version of a hardcopy paper*' fails to accurately describe what is being stored. The phrase '*content of the likeness*' fails to accurately describe applicant's invention and could be interpreted several different ways by one of ordinary skill in the art. The version stored could be interpreted as an individual HTML document. It is unclear to the examiner, what us meant by the term version and what defines the content of the likeness. As presently claimed, the content of the likeness could be software code, an image, a font, etc. The phrase, '*the detected reference being associated with a second location*' is vague and indefinite. One of ordinary skill in the art could conceivably derive

multiple ways to associate a reference with a second location. Furthermore, the phrase

'*embedding a link within the version <u>between the first location and the second location</u>*', could

be interpreted as a separate version distinct from both the first location and the second location.

Finally, the phrase, '*and the first location being: displayable on the display device as part of the*

likeness', fails to provide one of ordinary skill in the art with an accurate description of the

claimed invention. The language of the claim is such that a person of ordinary skill in the art

could not interpret the metes and bounds of the claim so as to understand how to avoid

infringement.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   **Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et**

al., Pub. No. US 2003/0200507 filed (06/02/03) in view of Hennings et al., USPN 6,763,496

filed (03/31/99).

In reference to independent claim 1, Stern teaches:

The version of the entity, which is stored in the mark-up language format, such as XML,

preferably contains the actual content of the newspaper object (compare to "*storing a version of*

a mass-produced printed paper"). See Stern, page 4, paragraph [0046].

The structure of the published content uses the interactive capabilities of the Web page to their fullest extent, by enabling the user to view different portions of the content in any desired order, *with links between these portions* being made according to the information in the content and/or according to the type of content (compare to "**forming a link within the version between a first location within the paper and a second location, the version being displayable on a display device as a likeness of the paper**"). See Stern, page 1, paragraph [0008]. Without any further description of the link within the limitations of the claim, the language does not preclude the Examiner from utilizing the links taught by Stern to provide a proficient description of Applicant's claim invention and more specifically, a link between two different locations of a paper.

The XML distiller module is able to recognize such features of the printed newspaper page as double pages, and the presence of different sections and subsections in the printed newspaper. Such an analysis is most preferably presented to the user through a graphic user interface in a visual representation (compare to "*the first location being displayable on the display device as part of the likeness*"). See Stern, page 4, [0041].

The reference discloses the presentation of different sections, subsections, and links, within a newspaper. The visual presentation may display each entity with a unique color, and displaying each element with a special hatching pattern and title. See Stern, page 4, [0041]. The reference fails to explicitly state highlighting the link and making the link selectable by a user to cause an operation associated with the second location. Hennings provides contextual information converting linked documents promoted to display pages that contain hyperlinks to those documents. The contextual information can be immediately displayed, or it can be

selectively displayed in response to a user selecting a text hyperlink anchor or a picture icon

hyperlink anchor. More specifically, a user typically views documents on the Internet with a web

browser. The web browser is able to distinguish hyperlinks from other HTML content, which

allows the browser to highlight the hyperlink anchors and/or change the cursor shape and/or

color to inform the user that the underlying text or graphic is a hyperlink (compare to

"highlighting to indicate the link and selectable by a user to cause an operation associated

with the second location"). See column 6, lines 45-67.

It would have been obvious to one of ordinary skill in the art, having the teachings of

Stern and Hennings before him at the time the invention was made, to modify the webpage

newspaper publication methods taught by Stern to include the hyperlink methods Hennings,

because it would have provided a view to newspaper publication information before accepting a

layout presented by the interactive capabilities of the web page to their fullest extent.

Furthermore, the information provided by the highlighted links taught by Hennings would have

provided extensive information to the user and allowed for the creation of precise structure for

the various newspaper objects.

In reference to dependent claim 2, Stern teaches:

Such relatively low quality may be caused by the relatively low level of the original font

and style recognition, and to error rate caused by the OCR (optical character recognition)

process, which may be as high as 0-20% of all characters or even higher. See Stern, page 4,

paragraph [0052].

In reference to dependent claim 3, Stern teaches:

The newspaper page is viewed as a collection of individual objects, which are organized according to a particular order on the printed newspaper page. Examples of such objects include, but are not limited to, a picture, a story, a headline, advertisements, and so forth. See Stern, page 2, paragraph [0026]. The reference does not explicitly disclose watch list term; however, the story or headline provides a similar feature as a watch term included within the newspaper because they are distinct objects within on the newspaper page and displayable to a user in a visual presentation.

In reference to dependent claim 4-6, Stern teaches:

The result could be the processing of the distinct objects within the newspaper page and could include, but are not limited to, a picture, a story, a headline, advertisements, and so forth. See Stern, page 2, paragraph [0026].

In reference to dependent claim 7, Stern teaches:

The user is then most preferably able to manually edit these intelligent analysis results. Also most preferably, XML distiller module is able to learn while the user is performing such a manual editing process. See Stern, page 4, paragraph [0041].

In reference to dependent claim 8, Stern teaches:

The reference discloses the presentation of different sections, subsections, and links, within a newspaper. The visual presentation may display each entity with a unique color, and displaying each element with a special hatching pattern and title. See Stern, page 4, [0041]. The reference fails to explicitly state highlighting the link and making the link selectable by a user to cause an operation associated with the second location. Hennings provides contextual

information converting linked documents promoted to display pages that contain hyperlinks to those documents. The contextual information can be immediately displayed, or it can be selectively displayed in response to a user selecting a text hyperlink anchor or a picture icon hyperlink anchor. More specifically, a user typically views documents on the Internet with a web browser. The web browser is able to distinguish hyperlinks from other HTML content, which allows the browser to highlight the hyperlink anchors and/or change the cursor shape and/or color to inform the user that the underlying text or graphic is a hyperlink (compare to *"highlighting to indicate the link and selectable by a user to cause an operation associated with the second location"*). See column 6, lines 45-67.

It would have been obvious to one of ordinary skill in the art, having the teachings of Stern and Hennings before him at the time the invention was made, to modify the webpage newspaper publication methods taught by Stern to include the hyperlink methods Hennings, because it would have provided a view to newspaper publication information before accepting a layout presented by the interactive capabilities of the web page to their fullest extent. Furthermore, the information provided by the highlighted links taught by Hennings would have provided extensive information to the user and allowed for the creation of precise structure for the various newspaper objects.

In reference to claims 9-16, the limitations reflect the system comprising instructions used for performing the methods as claimed in claims 1-8, respectively, and in further view of the following, are rejected under similar rationale.

In reference to claims 17-24, the limitations reflect the computer program product comprising

instructions used for performing the methods as claimed in claims 1-8, respectively, and in

further view of the following, are rejected under similar rationale.

Response to Arguments

8.   Applicant's arguments filed 7/5/05 have been fully considered but they are not

persuasive.

The Applicant believes the Stern reference does not exist in a hardcopy paper and teaches

away from a likeness of the hardcopy paper. The Examiner, believes the language found within

the amended independent claims fail to provide one of ordinary skill in the art with an accurate

description of the claimed invention. Moreover, a version of a hardcopy paper could be

interpreted several different ways by one of ordinary skill in the art. The phrase, '*storing a*

version of a hardcopy paper' fails to precisely explain what exactly is being stored. The generic

nature of a hardcopy paper provides a broad landscape of possible interpretations when read as

whole. The phrase '*content of the likeness*' fails to accurately describe applicant's invention and

could be interpreted several different ways by one of ordinary skill in the art. As presently

claimed, the content of the likeness could be a data structure, tags, an image, a font, etc. A

hardcopy paper could be a printed piece a paper which is a version of a newspaper. The language

of the claim is such that a person of ordinary skill in the art could not interpret the metes and

bounds of the claim so as to understand how to avoid infringement. The amended language is

vague and indefinite. Therefore, the Examiner has modified the rejection and added a rejection

under U.S.C. 112 2nd Paragraph.

The primary reference teaches a version of the entity, which is stored in the mark-up language format preferably contains the actual content of the newspaper object. Furthermore, Stern discloses a structure of the published document that uses the interactive capabilities of the Web page to their fullest extent, by enabling the user to view different portions of the content in any desired order, with links between these portions (compare to *"storing a version of a mass-produced printed paper"*). See Stern, page 4, paragraph [0046] and [0008]. Because the claim limitations are to be given their broadest reasonable interpretation within the scope of the art, the version of the entity taught by Stern suggests a *version* (webpage) of a stored hardcopy *paper*.

Without any further description of the link within the limitations of the claim, the language does not preclude the Examiner from utilizing the links taught by Stern to provide a proficient description of Applicant's claim invention and more specifically, a link between two different locations of a paper (compare to *"in response to the version, detecting a reference at a first location within the paper, the detected reference being associated with a second location"*). See Stern, page 4, [0041].

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
July 22, 2005

WILLIAM BASHORE
PRIMARY EXAMINER
7/22/2005